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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,222	10/30/2003	Van Dyke Garner	6037P2726	9784
23504	7590	12/19/2005	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/697,222

**Applicant(s)**

GARNER, VAN DYKE

**Examiner**

Peter Szekely

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The amounts claimed in claim 31 cannot be found in the specification.

### ***Claim Objections***

2. Claims 24 and 25 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form. The intended use does not further limit a composition.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Illustrative Examples (Tables 1-6) in the specification do not support the claims. While a plurality of resins, accelerators, emulsifiers, adsorbents, etc. are claimed, all Examples show only one surfactant, all but one show only one accelerator,

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Table 2 has only one absorbent and Table 1 contains one polymer. One of ordinary skill in the art, including the examiner, would be hopelessly confused, trying to duplicate applicants' invention with the plurality of one each of the claimed ingredients.

5. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a dry powder admixture, does not reasonably provide enablement for any kind of admixture. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See page 6, lines 21-22.

6. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an admixture having biodegradable ingredients, does not reasonably provide enablement for the admixture having the claimed ingredients. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See page 7, line 1. The claimed rubbers and vinyl esters are not biodegradable.

7. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no guidance in the specification about how many ingredients have to be there to fulfill the requirements of a "plurality", what the ratio of the ingredients have

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to be when more than one ingredient of the same use is needed. It is not conceivable that it does not make any difference whether one use two emulsifiers in the ratio of 1:1 or 16 of them in the ratio of 16:15:14:13:12:11:10:9:8:7:6:5:4:3:2:1. Furthermore, there is not even a hint of the advantages of using two absorbents instead of just one.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The multiple functions of the ingredients are confusing. The rubbers and the vinyl esters can be toughening resins, adhesive resins or water retentive agents. Polyvinyl acetate can fulfill a fourth function, namely overcoat resin. Perlite, calcium carbonate and diatomaceous earth can be either an adsorbent or a water-retaining agent. The list of accelerators of claim 18 and the list of air entraining agents of claim 19 are identical. It is not clear whether one material can fulfill several functions or in the presence of an isoprene rubber toughening resins a different adhesive resin and water retention agent is necessary or not.

11. Claims 5, 30 and 31 contain the indefinite phrase "less than about". It has to be either less or about not both. See *Amgen, Inc. v. Chubai Pharmaceutical Co., Ltd.*, 18 USPQ2d 1016 (Fed. Cir. 1991). Claim 9 contains the indefinite phrase "derivatives of alkyl ammonium, derivatives of aryl ammonium, derivatives of pyrrole and derivatives of piperidine". Carbon dioxide is a derivative of all of these compounds. It is derived by

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burning. Besides "alkyl ammonium, aryl ammonium" what? In claim 12 the "crumb form" is not understood. Crumb rubber is reground vulcanized rubber.

Claims 14, 18, 19, 21 and 23 contain the trademarks/trade names vinyl Versatate and Neodol 91-6. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a polymer and a surfactant and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kono et al. 6,165,263, in view of Emig et al. 4,039,345, Tokumoto et al. 4,710,526 or Dragon et al. 6,075,075.

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14. Kono et al. disclose a polymer, cement and water reducing agent in claims 1-6, emulsifiers in column 5, lines 10-57, accelerators in the paragraph overlapping columns 5 and 6 and column 6, lines 8-56, water retaining agents and other polymers in column 11, lines 22-41, defoamers in column 12, lines 1-32, alcohols and siloxanes in column 12, lines 33-43, air entraining agents in column 12, lines 44-52, other surfactants in the paragraph overlapping columns 12 and 13 and other additives in column 13, lines 15-22. For a plurality of aggregates see column 14, lines 32-67. Emig et al. teach cement, styrene-butadiene polymer and blend of surfactants in claim 1, defoamer in claim 1 and dodecylbenzene sodium sulfonate in claim 3. The copolymer is blended with other polymer latexes, e.g. vinylidene chloride polymer latexes (column 2, lines 8-24). Tokumoto et al. recite cement and polymer in claim 1, Initiators in the paragraph overlapping columns 3 and 4, surfactants in column 4, lines 8-24, polyvinyl alcohol and cellulose derivatives in column 4, lines 25-33, plasticizers in column 4, lines 53-68, perlite and calcium carbonate in column 5, lines 16-17, defoamer in column 5, lines 19-20 and blend of surfactants in Example I. Dragon et al. display mineral binder and modifying polymer in claim 1, emulsifiers in claim 4, 11 and 21, cement in claim 24, polyvinyl alcohol, cellulose derivatives and vinyl pyrrolidone copolymers in column 6, lines 42-52 and emulsifiers from column 6, line 53, through column 7, line 45. For initiators see column 7, lines 50-63. Thixotropic agent, antifoam and plasticizer can be found in column 9, lines 31-41. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use the ingredients of the secondary references, in the composition of Kono et al. since they all disclose cement admixtures.

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The ingredients ratios of the claims are immaterial, because only claims 30 and 31 disclose cement the intended use, i.e. "for cement" has no patentable significance.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely  
Primary Examiner  
Art Unit 1714

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12/12/05

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